

REMARKS

Claims 2-8 and 10-40 are pending in this application. Claims 7-8 and 15-16 have been allowed without the necessity of amendments. The Examiner's indication of allowability of these claims is noted with appreciation. For purposes of expedition, claims 2, 10, 11, 20, 22 and 23 have been amended in several particulars for purposes of clarity and brevity that are unrelated to patentability and prior art rejections in accordance with current Office policy, to further and alternatively define Applicants' disclosed invention and to assist the Examiner to expedite compact prosecution of the instant application.

Claims 2-3, 10, 17-19, 21-34 and 37 have been newly rejected under 35 U.S.C. §102(e) as being anticipated by Sawada et al., U.S. Patent Application Publication No. 2001/0021663 for reasons stated on pages 2-5 of the Office Action. In support of the rejection of base claims 2, 10 and 23, the Examiner now asserts that Sawada '663 discloses all aspects of Applicants' claimed invention. For example, the Examiner asserts that Sawada '663 discloses an electronic apparatus comprising:

"an electronic device including a body (see 21, fig. 8); and

a battery (22) coupled to the body to supply current to said electronic device, said battery further comprising a memory unit (42, 43, fig. 8) to store information (see par. 0041, 0055).

Wherein said battery further comprises a primary power connector to connect to said electronic device (see par. 008), and a secondary power output port to connect to another device having a controller to supply current thereto to power the controller (see par. 051-053, the reproducing device MPEG 3, ATRACT is [sic] inherently includes a controller itself and the battery pack 22 is inherently including a secondary power output to provides [sic] power to the reproducing device)."

In other words, the Examiner now asserts that the battery as disclosed on paragraphs 051-053 of Sawada '663 inherently includes "a secondary power output port to connect to another device having a controller to supply current thereto to power the controller", and that the reproducing device 54 included in the battery pack 53, as shown in FIG. 9, corresponds to Applicants' claimed "another device." However, the Examiner's assertion is misplaced. As a result, the rejection is respectfully traversed for reasons discussed herein below.

First of all, the rule under 35 U.S.C. §102 is well settled that anticipation requires that each and every element of the claimed invention be disclosed in a single prior art reference. In

re Paulsen, 30 F.3d 1475, 31 USPQ2d 1671 (Fed. Cir. 1994); In re Spada, 911 F.2d 705, 15 USPQ2d 1655 (Fed. Cir. 1990). Those elements must either be inherent or disclosed expressly and must be arranged as in the claim. Richardson v. Suzuki Motor Co., 868 F.2d 1226, 9 USPQ2d 1913 (Fed. Cir. 1989); Constant v. Advanced Micro-Devices, Inc., 848 F.2d 1560, 7 USPQ2d 1057 (Fed. Cir. 1988); Verdegall Bros., Inc. v. Union Oil Co., 814 F.2d 628, 2 USPQ2d 1051 (Fed. Cir. 1987). The corollary of that rule is that absence from the reference of any claimed element negates anticipation. Kloster Speedsteel AB v. Crucible Inc., 793 F.2d 1565, 230 USPQ2d 81 (Fed. Cir. 1986). However, inherency requires certainly, **not** speculation. The fact that a certain characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that characteristic. In re Rijckaert, 9 F.3d 1531, 28 USPQ2d 1955 (Fed. Cir. 1993); and In re Oelrich, 666 F.2d 578, 581-82, 212 USPQ 322, 326 (CCPA 1981). "To establish inherency, the extrinsic evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient. In re Robertson, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999). In relying upon the theory of inherency, the Examiner must provide a basis in fact and technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art. Ex Parte Levy, 17 USPQ 2d 1461, 1464 (Bd. Pat. App. & Inter. 1990).

In the present situation, there is **no** basis in fact for the Examiner to allege that the battery as disclosed on paragraphs 051-053 of Sawada '663 inherently includes "a secondary power output port to connect to another device having a controller to supply current thereto to power the controller".

As previously discussed, Sawada '663 discloses the use of a battery pack 22, as shown in FIG. 1 (1st embodiment), FIG. 5 (2nd embodiment), and FIG. 9 (3rd embodiment) for supplying a single electronic apparatus, such as a wireless telephone set, a PDA, and a camera, with electric power which can protect data stored in memories such as an IC card from being broken or lost. In both FIG. 5 (2nd embodiment) and FIG. 9 (3rd embodiment), the battery pack 22 is further built in a reproducing device 23 or 54 which is a music playback device used to transmit a radio signal of audio data to the portable telephone unit 21 or 51. However, since the reproducing device 23 or 54 is built inside the battery pack 22, the reproducing device 23 or 54

is automatically powered by the battery pack 22, and there is **no** need for such a battery pack 22 to include a power output port, as alleged by the Examiner. This is because the power output port is commonly used to supply to an external device, via a power cable, and not an internal device, such as disclosed by Sawada '663.

In contrast to Sawada '663, Applicants' base claims 3, 10 and 23 expressly define that the battery for an electronic device is not only provided with (1) a primary power connector used to power the electronic device, but also (2) a secondary power output port 211, as shown, for example, in FIG. 2, FIG. 3, FIGs. 4A-4B and FIG. 6, used to advantageously allow connection with another [external] device having a controller to supply current thereto to power the controller [of the another electronic device]," as shown in FIG. 6. This way the same battery can advantageously serve as a power source to at least two different electronic devices, that is, an electronic device in which it is attached to and intended for operation, and another, i.e., a different electronic device 300, such as a portable phone, a notebook computer or a PDA, as shown in FIG. 6, particularly, in the event where information contained in the memory unit of the battery needs to be shared or exchanged with the another electronic device 300. As a result, power from the same battery can be provided to different electronic devices at the same time.

Nevertheless, for purposes of expedition, base claims 2, 10 and 23 have been amended to clearly define the battery as having a secondary power output port arranged to receive insertion of a power plug of another device to supply current thereto to power a controller of the another device that is different from the electronic device and that is external to the battery. For example, base claim 2 has been amended to define a battery as comprising:

a memory unit to store information, a primary power connector to connect to said electronic device to supply current to said electronic device, and a secondary power output port arranged to receive insertion of a power cable of another device different from said electronic device and external to the battery to supply power to a controller of the another device.

Similarly, base claim 10 has been amended to define a battery for an electronic device, comprising:

a memory unit to store information;
a battery unit to store energy and which is connected to said memory unit;
a **primary power connector** arranged to connect to the electronic device to power the electronic device; and
a **secondary power output port** arranged to receive insertion of a power plug of another device to supply current thereto to power a controller of the

another device different from the electronic device,
wherein the battery is detachable from the electronic device, and
wherein the another device is external and detachable from the battery.

In view of these reasons and the foregoing amendments to base claims 2, 10 and 23, Applicants respectfully request that the rejection of claims 2-3, 10, 17-19, 21-34 and 37 be withdrawn.

Dependent claims 4, 12 and 31 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Sawada et al., U.S. Patent Application Publication No. 2001/0021663 for reasons stated on page 6 of the Office Action. Since this rejection is predicated upon the correctness of the rejection of Applicants' base claims 2, 10 and 23, Applicants respectfully traverse this rejection for the same reasons discussed. In addition, Applicants also note that claims 4, 12 and 31 further define the versatility of a communication port, which is not required or obvious in view of Sawada '663.

Dependent claim 11 has been rejected under 35 U.S.C. §103(a) as being unpatentable over Sawada et al. in view of Japanese Patent No. 2000165513A for reasons stated on pages 6-7 of the Office Action. Dependent claims 5 and 13 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Sawada et al. in view of newly cited art, Griffith et al., U.S. Patent No. 6,917,280 for reasons stated on pages 6-7 of the final Office Action. Dependent claim 20 has been rejected under 35 U.S.C. §103 as being unpatentable over Sawada et al., U.S. Patent Application Publication No. 2001/0021663, in view of Tringali et al., U.S. Patent No. 6,545,891 for reasons stated on page 8 of the Office Action. Lastly, dependent claims 35-36 and 38-40 have been rejected under 35 U.S.C. §103 as being unpatentable over Sawada et al., U.S. Patent Application Publication No. 2001/0021663, further in view of Wang, U.S. Patent Application Publication No. 2003/0013506 for reasons stated on pages 8-9 of the Office Action. In response thereto, Applicants respectfully traverse these rejections at least for the same reasons as discussed above, noting that neither Sawada '663, nor Japanese Patent No. 2000165513A, nor Griffith '280, nor Tringali '891, nor Wang '506 discloses or suggests Applicants' claimed "secondary power output port arranged to receive insertion of a power cable of another device different from said electronic device and external to the battery to supply power to a controller of the another device" as defined in base claims 2 and 10.

In view of the foregoing amendments, arguments and remarks, all claims are deemed to be allowable and this application is believed to be in condition to be passed to issue. Should

any questions remain unresolved, the Examiner is requested to telephone Applicants' attorney at the Washington DC office at (202) 216-9505. Applicants respectfully reserve all rights to file subsequent related application(s) (including reissue applications) directed to any or all previously claimed limitations/features which have been amended or canceled, or to any or all limitations/features not yet claimed, i.e., Applicants have no intention or desire to dedicate or surrender any limitations/features of the disclosed invention to the public.

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Respectfully submitted,

STEIN, MCEWEN & BUI, LLP

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By: Hung H. Bui
Hung H. Bui
Registration No. 40,415

1400 Eye St., NW
Suite 300
Washington, D.C. 20005
Telephone: (202) 216-9505
Facsimile: (202) 216-9510